

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks.

The specification has been amended editorially as listed above.

Claims 3, 4, 11, 18, 20, 22, and 24 have been canceled without prejudice.

Claim 1 has been amended as supported by the specification at page 8, lines 12-17 in addition to editorial revisions; claims 5, 26, and 28 have been amended editorially.

New claim 30 includes elements of canceled claim 18 in an independent form.

The specification has been objected to as providing no antecedent basis for the claimed subject matter. Page 18 of the specification has been amended to clarify the correspondence to the language of the claims. Accordingly, this objection should be withdrawn.

Claims 8 and 22 have been objected to as being in improper dependent form. Claim 22 has been canceled, and this objection is moot. In claim 1, "by heating" is recited as part of the limitation "capable of generating...by heating". This defines a property of the material and does not require a specific step. Claim 8 specifically requires a heating step, and thus further limits claim 1. Accordingly, this objection should be withdrawn.

Claim 20 has been objected to because of informalities. Claim 20 has been canceled, and this objection is moot.

Claims 5, 19, 21, 23, 25-27, and 29 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

A written description for a generic claim is not required to include every possible embodiment falling within that scope. McMullin v. Carroll, 153 Fed. Appx. 738, 743 (Fed. Cir. 2005). The test for the written description is whether those skilled in the art would understand that the applicant possessed the invention based on the disclosure in the specification. Id. Claim 5 is disclosed in the specification at page 15, lines 12-17, and use of examples of materials containing alkali-earth metal such as SrO_3 and BaCO_3 and a material containing rare earth metal such as Eu_2O_3 are disclosed in examples 1 and 3 at pages 23 and 28 and example 2 at page 26 in the specification, respectively. In addition, in comparative example 1, a nitride of alkali-earth metal Sr_3N_2 was used instead of SrO_3 of example 1 and carbon black was intentionally eliminated from the synthesis system (see comparative example 1 at page 24 in the specification). Therefore, those skilled in the art would understand that Applicants possessed the invention of claim 5 including the use of nitrides as starting materials at the time of the invention. Claim 5 and its dependent claims 19, 21, 23, 25-27, and 29 comply with the written description requirement, and this rejection should be withdrawn.

Claims 1 and 3 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant respectfully traverses this rejection.

Claim 3 has been canceled. Claim 1 has been amended editorially to clarify the process. Accordingly, claim 1 is definite, and the rejection should be withdrawn.

Claim 1-4, 7-9, 11, 20, 22, and 24 have been rejected under 35 U.S.C. 102(b) as being anticipated by Mitomo (U.S. Patent No. 4,851,205). Applicant respectfully traverses this rejection.

Claims 3-4, 11, 20, 22, and 24 have been canceled. Therefore, the rejections of these claims are moot. Mitomo is dedicated to aspects of α -SIALON powder (see coln. 1, lines 8-13 and 40-45), and the reference discloses α -SIALON including a minor

portion of β -SIALON (see coln. 3, lines 54-58). Claim 1 requires the prohibition of nitridosilicate-based compounds that are not in the SIALON-type structure. Accordingly, claim 1 is distinguished from Mitomo, and this rejection should be withdrawn.

Claims 3, 4, 11, 20, 22, and 24 have been rejected under 35 U.S.C. 102(b) as being anticipated by Fanelli et al. (U.S. Patent No. 5,292,489). Applicant respectfully traverses this rejection.

Claims 3, 4, 11, 20, 22, and 24 have been canceled. Therefore, this rejection is moot and should be withdrawn.

Claims 13 and 28 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Mitomo (U.S. Patent No. 4,851,205) in view Sakata et al. (U.S. Patent No. 7,144,524). Applicant respectfully traverses this rejection.

Claims 13 and 28 are distinguished from Mitomo for at least same reasons as discussed for claim 1 above. Japanese priority application No. JP 2004-149616 of this application was filed on May 19, 2004, which is prior to the July 16, 2004 U.S. filing date of Sakata. Therefore, Sakata is not prior art against claims 13 and 28 (see the translation of JP 2004-149616 attached hereto). Accordingly, this rejection should be withdrawn.

In view of the above, Applicant requests reconsideration of the application in the form of a Notice of Allowance.



Dated: September 10, 2008

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